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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/824,580      | 04/03/2001  | Joseph D. Rutledge   | YOR9-2000-0724US1   | 8717             |

7590 05/18/2005  
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EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/824,580

Applicant(s)

RUTLEDGE ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Argument***

1. The affidavit filed on November 18, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wilk reference, because the 2<sup>nd</sup> paragraph “before November 22.....” is just a statement without facts to support such statement.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wilk reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The complete claimed invention was not conceived prior to the date of the Wilk reference because the attached Invention Disclosure No. BOC8-2001-0004 does not support all the claimed limitations recited in claims 2, 7-9 and 14-17. There is no support for example, of limitation “means for disabling a ringer on said telephone in response to said greeting button being pushed”.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wilk reference to either a constructive reduction to practice or an actual reduction to practice.

Further, No evidences were provided to support the statement that applicants exercised due diligence from 11/21/2000 to 02/16/2001.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilk (U.S. Patent No. 6,768,789).

Regarding claim 1, Wilk teaches a wireless telephone 28 (i.e., telephone) (fig.1).

Wilk teaches a storage device (i.e., means) for producing n pre-recorded messages (i.e., greetings) where n is an integer of one or greater (fig.1, 2; col.2, lines 36-41, col.4, lines 10-31, col.5, lines 34-36).

Wilk further teaches keypad (i.e., means) for selecting one of the n pre-recorded messages after the wireless telephone 28 has begun to ring (fig.2; col.2, lines 36-41, col.5, lines 34-48).

Regarding claim 2, Wilk teaches local base station (i.e., means) for inherently stopping the telephone from ringing when the means for selecting is activated (fig.1, 2; col.3, lines 50-55, col.5, lines 12-16, 49-51, 57-62).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Shnier (U.S. Pub. No. 2002/0009184).

Regarding claim 3, Wilk fails to teach “each of said n greetings comprise a message indicating a time when a call will be returned as a function on n”. Shnier teaches each of the n greetings comprising a message indicating a time when a call will be returned as a function on n (page 6, paragraph 0065). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow each of the n greetings comprising a message indicating a time when a call will be returned as a function on n as taught by Shnier. The motivation for the modification is to have doing so in order to provide a reminder to the caller to callback at a later time.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Cronin (U.S. Patent No. 6,216,016).

Regarding claim 4, Wilk fails to teach “a first of said n greetings comprises a message instructing a caller to hold”. Cronin teaches a first of the n greetings comprising a message instructing a caller to hold (col.1, lines 58-61). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow a first of the n greetings comprising a message instructing a caller to hold as taught by Cronin. The motivation for the modification is to have doing so in order to allow a moment for the called party so that he can answer the call.

8. Claims 5, 8, 10, 9, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Chen (U.S. Patent No. 6,009,444).

Regarding claim 5 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Wilk fails to teach that means for determining how many times the greeting button has been pushed and the selected message corresponding to a number of times the greeting button was pushed. Chen teaches means for determining how many times the key 1 (i.e., greeting button) has been pressed (i.e., pushed) and the Chinese phonetic symbol (i.e., selected message) corresponding to a number of times the greeting button was pushed (fig.1; col.3, lines 11-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow means for determining how many times the greeting button has been pushed and the selected message corresponding to a number of times the greeting button was pushed as taught by Chen. The motivation for the modification is to have doing so in order to produce different symbols using the same key.

Regarding claims 8, 13 and 17, Wilk teaches means for storing a caller's message (col.5, line 65- col.6, line 4).

Regarding claim 9, Wilk teaches inherently an indicator on the telephone for notifying (i.e., reminding) that a call has been received (col.5, lines 12-16).

Regarding claims 10 and 14 are rejected for the same reasons as discussed above with respect to claim 5.

Regarding claims 12 and 16, Wilk teaches obtaining the caller's telephone number (col.5, lines 12-16).

Wilk further teaches including the caller's telephone number in the selected greeting (col.4, lines 10-31, col.5, lines 12-16, 34-48).

9. Claims 6, 7, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Shnier (U.S. Pub. No. 2002/0009184).

Regarding claims 6, 7, 11 and 15 are rejected for the same reasons as discussed above with respect to claim 3.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rydbeck (U.S. Patent No. 6,574,471) teach Apparatus and method for handling incoming calls received by a portable intelligent communications device during a meeting.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*M. E.*

MD SHAFIUL ALAM ELAHEE  
May 2, 2005

  
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